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Yoshikazu Kato

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

09/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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DETAILED ACTION

Acknowledgements

1. This action is in reply to the Amendments and Remarks filed on 15 July 2008.
2. Claims 1-5 and 7-9 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20080917. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 112, 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
7. Regarding claims 3 and 9: These claims recite “said content data in effect before being combined into said single item”. These claims are indefinite because one of ordinary skill in the

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art would not understand how the data previously composed by the composing means, referring to parent claims 1 and 7, is now in these claims equivalent to the data being combined by the composing means.

8. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5 and 7-9, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Saylor et al. (U.S. 6,788,768 B1) ("Saylor").

11. Regarding claim 1:

a. Saylor discloses the following limitations:

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- i. *storing means* (“databases”) *for storing content data* (see at least column 9, lines 35-65);
- ii. *managing means* (“voice service”) *for managing preference data by which to determine preferences of a user based on a quantity of previous orders with respect to a genre* (see at least column 9, lines 13-65);
- iii. *reading means* (“voice service”) *for reading said content data from said storing means in response to an instruction from said user* (see at least column 9, lines 13-65);
- iv. *sorting means* (“voice service”) *for sorting said content data read by said reading means, in accordance with said preference data managed by said managing means* (see at least column 10, lines 4-37); *and*
- v. *composing means* (“voice service”) *for composing said content data sorted by said sorting means, into a single item for distribution to said user* (see at least column 10, lines 37+).

12. Regarding claim 2:

b. Saylor discloses the limitations of claim 1, as described above. Saylor, further, discloses the following limitations:

- vi. *wherein said managing means determines said genre of said content data read by said reading means and associates the number of times content data belonging to said genre thus determined have been read, with information for identifying said user for management purposes* (see at least column 9, line 13 through column 10, lines 67).

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13. Regarding claim 3:

c. Saylor discloses the limitations of claim 1, as described above. Saylor, further, discloses the following limitations:

vii. *wherein said content data in effect before being combined into said single item by said composing means include at least information for distinguishing said content data from other content data and information for indicating where said content data are stored in said storing means (see at least column 9, line 13 through column 10, lines 67).*

14. Regarding claims 4, 5, and 7-9:

d. These claims are understood by the Examiner to be of substantially the same scope as claims 1-3. Accordingly, claims 4, 5, and 7-9 are rejected in substantially the same manner as claims 1-3. If in response to this action the Applicant disagrees that the claims are of substantially the same scope, and provides evidence that they are of different scope, the Examiner may withdraw this rejection under §103(a) and alternatively impose a restriction requirement.

15. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the

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claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

16. In light of Applicant's choice to pursue product claims, Applicant is reminded that functional recitations using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* see claim 1 which recites "into a single item for distribution to said user") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

17. Although Applicant uses "means for" in the claims (*e.g.* see claim 1 which recites "storing means for storing content data"), it is the Examiner's position that the "means for" phrases do not invoke 35 U.S.C. 112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of "means for" from the claims, or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked. Alternatively, if Applicants desire to invoke 35 U.S.C. 112 6th paragraph, the

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Examiner respectfully requests Applicants to expressly state their desire on the record. Upon receiving such express invocation of U.S.C. 112 6th paragraph, the “means for” phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*. Failure by Applicants in their next response to also address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111 (b) or to be non-responsive to this issue entirely will be considered a desire by Applicants NOT to invoke 35 U.S.C. 112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6th paragraph applies to all examined claims currently pending.

Response to Arguments

18. Applicant's arguments with respect to claims 1-5 and 7-9 have been considered but are moot in view of the new grounds of rejection.

Conclusion

19. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see e.g. “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of

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the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

20. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C. Coppola/
Patent Examiner, Art Unit 3621
September 17, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621